REMARKS

The Office Action dated October 19, 2004, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 34, 35, 37, 38, 46, 47, 51-53, 55, 56, 63 and 64 have been amended to more particularly point out and distinctly claim the subject matter of the invention. New claim 66 has been added. No new matter has been added, and no new issues are raised which require further consideration and/or search. Claims 34-66 are respectfully submitted for consideration.

The Office Action objected to the title of the invention as not being descriptive and required a new title. The title of the invention has been amended above and Applicants respectfully assert that the title is now descriptive of the invention claimed and respectfully request that the objection be withdrawn.

Claims 34-65 were rejected under 35 USC § 103(a) as being unpatentable over *Lim* (U.S. Patent no. 6,349,224) in view of *Wang et al.* (U.S. Patent no. 6,230,024). The Office Action took the position that *Lim* disclosed all of the elements of the claimed invention, with the exception of "checking the result of the setup processing and indicating the setup process were successful." *Wang et al.* was cited as curing the deficiencies in *Lim*, and the Office Action took the position that it would have been obvious to a person of ordinary skill in the art to combine *Lim* and *Wang et al.* to yield

the claimed invention. Applicants respectfully submit that the presently pending claims recite subject matter which is neither disclosed nor suggested in the cited prior art.

Claim 34, from which claims 33-51 and 61 depend, recites a method for establishing a connection in a telecommunication network comprising different protocols, and an interworking function (MSC, IWF) for adapting the different protocol features used for a connection between a calling terminal and the interworking function, and the interworking function and the called terminal. The method includes the steps of receiving at the interworking function from a calling terminal a request to establish a connection of a first type (multimedia connection) using first protocol features, performing a setup processing according to the first protocol features used for the first type of connection between the interworking function and the called terminal, determining a second type of connection, checking the result of said setup processing so as to indicate whether or not the setup processing according to the first protocol features has been successful and, when said checking step indicates that said setup processing was not successful, establishing said second type of connection between the interworking function and the called terminal and changing the connection between the calling terminal and the interworking function to the second type of connection.

Claim 52, from which claims 53-60 and 62-65 depend, recites a system for establishing a connection in a telecommunication network comprising different protocols. The system includes negotiating means implemented as an interworking function (MSC, IWF) for adapting the different protocol features used for a connection between a calling

terminal and the interworking function and the interworking function and a called terminal, said negotiating means being adapted for, when receiving at the interworking function from a calling terminal a request to establish a connection of a first type (multimedia connection) using first protocol features, performing a setup processing according to the first protocol features used for the first type of connection between the interworking function and the called terminal, determining means for determining a second type of connection, checking means for checking a result of said setup processing so as to indicate whether or not the setup processing according to the first protocol features has been successful and connection control means for establishing said second type of connection between the interworking function and the called terminal and changing the connection between the calling terminal and the interworking function to the second type of connection, in response to the checking result of said checking means.

As discussed in the present specification, the present invention enables an interworking function is provided performing protocol conversion between a calling terminal and a called terminal. When a setup processing between the InterWorking Function IWF and the called terminal according to a first protocol specified by the calling terminal should not be successful, the connection between IWF and the called terminal is changed to a second connection type, and similarly, the connection between the calling terminal and the IWF is likewise changed to the second connection type. It is respectfully submitted that the prior art of *Lim* and *Wang et al.*, when viewed or when combined, fails to disclose or suggest the elements of any of the presently pending

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claims. Therefore, the prior art fails to provide the critical and unobvious advantages discussed above.

Lim discloses a prior art structure (Figures 1 to 3) wherein an InterWorking Unit IWU is provided for protocol adaptation. *Lim* tries to arrive at a process of data communication <u>without</u> using any IWU, as illustrated in Figures 4, 5 and discussed in the specification of *Lim*. The rejection incorrectly mixes, when evaluating *Lim*, statements in *Lim* related to the prior art using IWU, and statements related to the claimed implementation <u>not</u> using IWU. As an example, discussions in column 3 of *Lim* are directed to the implementation <u>without</u> using IWU.

Lim <u>does not</u> disclose the features of checking the result of setup processing between IWU and the called terminal, and changing, if unsuccessful, to another protocol type. It appears that the rejection correctly acknowledges at least the first part of this difference. However, the Office Action takes the position that *Wang et al.*, taken together with *Lim*, can render obvious such check and change.

Wang et al. relates to a wireless communication network wherein a mobile station can be used both for voice calls and digital fax transmission. An ongoing voice call can be converted to a digital fax call without forcing the user to re-establish the call for fax transmission. The base station or mobile station can initiate a digital fax call even though a voice call is taking place, when either receiving a PSTN generated fax tone, or when receiving a specified command from a fax device or computer connected to the mobile station.

In *Wang et al.*, the setup processing between the intermediate component BS/MSC/<u>IWF</u> 114 (Figures 2, 3), and the called terminal (fax of PSTN 128) has to be successful before switching to the fax transmission. This would be contrary to the claimed feature of checking the result of setup processing, and switching protocol, when the setup processing was unsuccessful.

As recited in claim 34, the result of said setup processing is checked "so as to indicate whether or not the setup processing according to the first protocol features has been successful." Additionally, when it is determined that the setup processing was <u>not</u> successful, then the second type of connection is established and the connection is changed. Similar subject matter is recited in independent claim 52. Thus, *Wang et al.* provides for connection when successful rather than unsuccessful and cannot be used to render the claims obvious. As such, Applicants respectfully assert that the combination of Lim and *Wang et al.*, cannot teach or suggest all of the elements of claims 34 and 52, and claims dependent thereon.

In view of the above, Applicants respectfully submit that claims 34-65 each recite subject matter which is neither disclosed nor suggested in a combination of *Lim* and *Wang et al.* Newly added claim 66 also recites elements that are also neither taught or suggested by *Lim* and *Wang et al.* It is therefore respectfully requested that all of claims 34-66 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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